

REMARKS

Claims 5-8 and 10-16 are pending in this application. By this Amendment, claim 8 is amended. The amendments introduce no new matter. Support for amendment can be found in the original claims, as filed. A Request for Continued Examination is attached. Reconsideration of the application based on the above amendments and the following remarks is respectfully requested.

The Office Action rejects claim 5-16 under 35 U.S.C. §101 as being directed to non-statutory subject matter. This rejection is respectfully traversed.

The Office Action asserts that the rejected claims are directed to software *per se*. However, MPEP §2106.01(I) provides that finding claims directed to software *per se* is proper only when the claimed invention taken as a whole is directed to a mere program listing, *i.e.* to only its description or expression, it is descriptive material *per se* and hence non-statutory. The rejected claims recite more than a mere program listing. For example, at least the storage part, output part and deletion part, as recited in claim 5, and similar parts recited in claims 8, 11 and 14, satisfy the requirements of 35 U.S.C. §101.

MPEP §2106.01(I) also provides that a computer program may be part of an otherwise statutory manufacture or machine. In such cases, the claim remains statutory irrespective of the fact that a computer program may be included in the claim. In other words, merely because aspects of a claim could be embodied by a computer program, does not render the overall claim non-statutory.

In this regard, the Office Action attempts to rely on a possible construction of the claims that would allegedly render the claims software *per se*. However, software *per se* does not store, output, or delete data unless embodied in an apparatus capable of performing such functions. Additionally, MPEP §2106.01(I) states "[w]hen a computer program is recited in conjunction with a physical structure, such as a computer memory, USPTO personnel should

treat the claim as a product claim." Thus, at least the storage part storing the instruction form must be treated as statutory subject matter. In this case, for at least the reasons argued to date in prosecution of this application, and particularly in the March 26, 2008 Pre-Appeal Brief Request for Review, the pending claims clearly recite several features, if not all, that comply with §101.

The Office Action also asserts that the above features cannot "link" to a hardware feature because a storage part allegedly reads on a software element. This analysis is incorrect. Software *per se* cannot store, or output, data without some tangible embodiment. That is, a program listing itself does not store, or output, data.

Further, claims 5, 8, 11 and 14 recite, among other features, various apparatuses, such as the instruction form management apparatus and the instruction form execution apparatus. At least these features define structural features of the relevant apparatuses. As such, claims 5, 8, 11 and 14, and claims 6, 7, 9, 10, 12, 13, 15 and 16 for at least their respective dependence on claims 5, 8, 11 and 14, are understood to recite statutory subject matter.

The Office Action rejects claims 5-16 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. This rejection is respectfully traversed.

The Office Action asserts that the feature of an "instruction form," as recited in claims 5, 8, 11 and 14, is allegedly ambiguous. The analysis of the Office Action fails for at least the following reasons.

The Office Action asserts that the feature of an instruction form is not clear because of the deletion, recited in the pending claims, allegedly because deletion of an original template means that a user cannot get it back after deletion. However, deletion is clearly set out in the Applicant's specification in the context of the overall information management apparatus. Additionally, the Examiner has not set forth any basis for why the question of whether or not

a user can get an instruction form back after it has been deleted is dispositive of a determination of compliance with §112.

The second paragraph of 35 U.S.C. §112 requires claims to be set out and circumscribe a particular area with a reasonable degree of precision and particularity. *In re Johnson*, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). The test for compliance with 35 U.S.C. §112, second paragraph, is whether one skilled in the art would understand the bounds of the claims when read in light of the specification. *Miles Lab., Inc. v. Shandon Inc.*, 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993), *cert. denied*, 510 U.S. 1100 (1994). If the claims, read in light of the specification, reasonably apprise those skilled in the art of the scope of the invention, Section 112 demands no more. *See, also, In re Merat*, 519 F.2d 1390, 1396, 186 USPQ 471, 476 (CCPA 1975), which stated that the question under Section 112, second paragraph is whether the claim language, when read by a person of ordinary skill in the art in light of the specification, describes the subject matter with sufficient precision that the bounds of the claimed subject matter are distinct. *See, also, In re Warmerdam*, 33 F3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

One of ordinary skill in the art would readily understand the term "instruction form" when read in the context of each of the independent claims. For example, each of the independent claims recites an instruction form that indicates a process to be executed to a document. Moreover, the meaning of this term is clear when read in light of the specification. For example, page 6, line 11 - page 7, line 5, of the specification describes the term "instruction form" with sufficient precision.

In construing the pending claims as indefinite, the Office Action again relies on an extreme and impermissibly narrow construction of the claims. Section 112 requires that, if the Examiner deems the pending claims to be ambiguous, the Examiner must refer to the Applicants' specification in construing and resolving the ambiguities. In this regard, MPEP

§2111.01(II) provides that when interpreting a claim term which is ambiguous, Examiners must look to the specification for the meaning ascribed to that term by the inventor. In each of the enumerated alleged ambiguities identified by the Office Action, the Applicants' provide adequate support for these features in the specification, at least such that one of ordinary skill in the art would understand them to be clear and definite.

For at least these reasons, one of ordinary skill in the art would readily understand the term "instruction form" recited in each of the independent claims and thus, contrary to the Office Action's assertions, the term is not ambiguous. As such, the rejection of claims 5-16 under §35 U.S.C. §112, second paragraph is improper.

The Office Action, on page 6, rejects claims 5-16 under 35 U.S.C. §102(b) over Oracle⁹ⁱ case studies-XML applications, 2001 (hereinafter "Oracle"). This rejection is respectfully traversed.

MPEP §2131.01 states "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (emphasis added) *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ.2d 1051, 1053 (Fed. Cir. 1987). This standard is not met here for at least the following reasons.

Oracle does not teach a storage part that stores an instruction form that indicates a process to be executed to a document by at least one of a plurality of instruction form execution apparatuses connected to the instruction form management apparatus, as recited in claim 5, and similarly recited in claim 14; a generation part that generates an instruction form that indicates a process to be executed to a document by the at least one instruction form execution apparatus, as recited in claims 8 and 11, and a copying part, as recited in claim 8 and now-canceled claim 9.

The Office Action asserts that Oracle teaches a system with features that allegedly can be considered to correspond to these features. Oracle teaches a system that allows a user to fill in an order form which is then output to a supplier after the user clicks on "Place Order" (see, e.g., Fig. 8-5). Oracle further teaches that once the order form is output to the supplier, the data that was entered into the form is deleted (see, e.g., Fig. 8-5). Oracle, however, does not teach a storage part that stores an instruction form that indicates a process to be executed to a document or a generation part that generates an instruction form that indicates a process to be executed to a document, as recited in the pending claims, or a copying part in combination with all of the features recited in claim 8

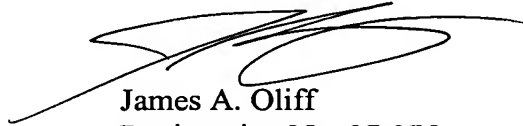
For at least the foregoing reasons, it is unreasonable to assert the Oracle teaches, or would have suggested, the combination of features recited in claims 5, 8, 11 and 14. Additionally, claims 6, 7, 10, 12, 13, 15 and 16 are also not taught, nor reasonably suggested, by the applied reference for at least their respective dependence on claims 5, 8, 11 and 14, as well as from the separately patentable subject matter that each of these claims recites.

Accordingly, reconsideration and withdrawal of the rejection of claim 5-8 and 10-16 under 35 U.S.C. §102(b) are respectfully requested.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 5-8 and 10-16 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Attachments:

Request for Continued Examination
Petition for Extension of Time

Date: June 25, 2008

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